

REMARKS

This Response is to the Office Communication mailed on 14 November 2006 (Paper No. 20061111), which was issued in response to Applicant's Amendment filed on 20 April 2006, and is a supplemental response to the Office action mailed on 20 October 2005 (Paper No. 20051011). In the Communication, the Examiner states that the previously filed Reply Brief was not fully responsive to the prior Office Action because of the following omissions or matters:

Listing of the Claims

Claims 38 through 81 are pending in the application, and are set forth in the following listing. Pursuant to 37 CFR §121(c), the claim listing, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Status of Pending Claims

Claims 38 through 81 are pending in the application. Claims 1 through 37 were previously canceled without prejudice or disclaimer of their subject matter.

Amendment of the Claims

Claims 55, 64 and 72 are amended.

Objection to Claims 55, 64 and 72

Paper No. 20070510 raised several objections to Claims 55, 64 and 72. With one exception, these claims are amended to remove the basis for these objections. In the single instance, Paper No. 20070510 questioned whether in claim 64, at line 14, the article "a" should be inserted before "reception"? As a general rule, when used as a subject, in the passive voice, the verb *reception* should not be preceded by either the article "a" or "the."

Accordingly, withdrawal of this objection is respectfully requested.

Rejection of Claims 55, 64 and 72 Under 35 U.S.C. §112

Claims 44 and 64 are rejected under the second paragraph of 35 U.S.C. 112, as being possibly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses both of these rejections for the following reasons.

In support of this rejection, the Examiner questioned whether:

“The language of claim 45 in line 22 is confusing (e.g., ...connected to said memory via a network printing to download said finalized ...). Claim 45 should be amended to more clearly set forth the claimed invention.”

This excerpt from claim 45 omits the comma that is present between “network” and “printing.” When the excerpt is read with this comma, claim 45 is grammatically correct.

“Claims 55-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language of claim 55 in line 3 is confusing (e.g., ...connected, via the Internet, each customer accessing a home page ...). Claim 45 [*sic*, “55”] should be amended to more clearly set forth the claimed invention.”

This excerpt incorrectly alters the tense of the introductory verb “connecting”. Line 3 of claim 55 reads, “connecting, via the Internet, each customer accessing a home page of a printing agency” No amended is indicated by the current text of claim 55.

Applicant notes that Paper No. 20070510, PTOL-326, states that it is directed to Applicant’s amendment filed on the 16th of March 2007. Applicant’s Second Supplemental Amendment was filed on the 15th of March 2007. A copy of that Second Supplemental Amendment, together with its postcard receipt, is enclosed for the Examiner’s convenience.

Claim Rejections - 35 U.S.C. § 103

Claims 38-81 are rejected under 35 U.S.C. 103(a) as being obvious over Sevcik (U.S. Patent No. 6,330,542) in view of Herbert (U.S. Patent No. 6,707,931).

Claims 38 through 81 are rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable over the Examiner's proposed combination of Sevcik (U.S. Patent No. 6,330,542) modified according to Herbert (U.S. Patent No. 6,707,931). Applicant respectfully traverses this rejection for the following reasons.

In support of this rejection, Paper No. 20070510 avers that:

Sevcik discloses an apparatus for printing, the apparatus comprising:

a server with a corresponding home page accessible through the Internet (Sevcik: Fig. 1 A, "38"), said server receiving a cost request through the Internet from a user, the cost request including a request for an estimate of a cost of a print job and including identification data corresponding to the user, the cost request including first data about the print job (Sevcik: column 5, lines 2-10);

a first memory unit storing the cost request and the identification data received from said server, said first memory unit being in communication with said server (Sevcik: column 14, lines 23-29);

said server sending a cost estimate through the Internet to a destination corresponding to the identification data, the cost estimate being generated in dependence upon the received cost request, the cost estimate including a password and the estimate of the cost of the print job, said server receiving the password and print data through the Internet from the user when the user receives and approves the cost estimate, the print data being the information to be recorded on recordable media (Sevcik: column 15, lines 13-25);

an output device receiving the print data, and recording the print data in the final form on the recordable media (Sevcik: Fig. 16).

Herbert discloses an apparatus for printing, the apparatus comprising:

an editing unit being in communication with said server, said editing unit editing the print data received by said server through the Internet from the user when the print data is not in a final form, said editing unit being distinguishable from the user (Herbert: Fig. 7, "110");

a second memory unit storing the print data when the print data is in the final form, said second memory unit being in communication with said editing unit (Herbert: Fig. 7, "116");

an output device receiving the print data in the final form from said second memory unit, and recording the print data in the final form on the recordable media (Herbert: Fig. 7, "118"). At the time of invention it would have been obvious for one skill in the art to have modified the method of Sevcik to have included the teachings of Herbert in order to allow a remote viewer to view or modify a digital product (Herbert: column 1, lines 10-16).

This rejection fails to make a *prima facie* showing of obviousness for the following reasons.

First, the newly cited Herbert '931 is unavailable as prior art under 35 U.S.C. §103(a), because the U.S. filing date of Herbert '931, namely the 26th of April 2002, is long after Applicant's U.S. filing date of the 6th of June 2001.

Under 35 U.S.C. §103(a), "the prior art" is defined by reference to the several paragraphs "set forth in section 102." Herbert '931 does not qualify as "prior art" under any of those sections. Accordingly, this rejection is specious, and may not be maintained. It withdrawal and allowance of claims 38 through 81 is respectfully solicited.

Second, Applicant notes that the Examining staff's detailed analysis of Herbert '931 is persuasive evidence of record of the subject matter to which Applicant is entitled by right of priority in the Office. For example, Applicant is an "09/" series application while Herbert '931 is a "10/" series application filed only after exhaustion of serial numbers in the "09/" series. Applicant agrees with the Examining Corps that Applicant is dominant, and senior, to any residual right to which Herbert '931 may be entitled; it is unclear however, whether the Examining staff is also making a suggestion for Applicant to copy claims? Written clarification pursuant to 37 CFR §1.104(a) and (b) in subsequent Office correspondence is

respectfully requested.

Third, the rationale given by the Examiner in support of this rejection ignores the express teachings of the Examiner's proposed combinations. Specifically, the Examiner's assertion that "it would have been obvious to one skilled in the art to have modified the method of Herbert in order to allow a remote viewer to view or modify a digital product (Herbert: column 1, lines 10-16)" ignores the express teaching of Herbert '931 that in order to attain the Examining staff's proposal "to have modified the method of Sevcik to have included the teachings of Herbert in order to allow a remote viewer to view or modify a digital product (Herbert: column 1, lines 10-16)" necessarily requires that "image server monitor 22 and client monitor 28 are color calibrated"¹ in conform to the teaching of the Examiner's proposed combination. Absent this feature, the Examiner's proposed combination is untenable under the express teachings of the applied art. This feature is of questionable merit and expense in the practice of Applicant's disclosed embodiments.

Moreover, the foregoing additional expense attributable to the Examiner's proposed combination is not negligible. Specifically, in the Examiner's proposed combination, in order "to have modified the method of Sevcik to have included the teachings of Herbert in order *to allow a remote viewer to view or modify a digital product* (Herbert: column 1, lines 10-16)", "the digital information 68 including changes to the digital images, video conferencing information 70 between the printer and the client, and approval information form [*sic*, "from"] the client 72. This information can be recorded, copied to a transportable medium, archived, sent to the client, or sent to the printer. As well as the above stored information, the system can track other characteristics of the session for such purposes as accounting. For example, the time elapsed during the press proof session, the amount of data transmitted from the printers to clients, the number of still images transmitted, and the number of clients contacted to a printer. Such information is advantageous *for invoicing* the

¹ Herbert '931, at column 5, lines 43 and 44.

printer, the client, or both for use of the system.”² Where therefore, in the Examiner’s proposed combination is the remnants of Sevek ‘542’s “quoting process in order to provide a price for custom print jobs”? As was noted in Applicant’s response filed on or about the 14th of March 2007, the primary reference depends upon the flawless determination of costs as a matter of business practicality, because:

“[f]or every job, there is a series of steps, which occur from when the quote is generated, to when the job is closed. Each of these steps is tracked within the system.”³

Moreover, the primary reference makes no provision for generation of an estimate prior to the user contracting with the graphics contractor taught by Herbert ‘931, and instead in the Examiner’s proposed combination expressly allocates the responsibility ... to find a printer to the customer, while both Sevek ‘542 and Herbert ‘931 are dedicated to providing “a more efficient system that not only addresses the needs of buyers, but also the needs of the printing provider ... [by providing] the buyer with quotations that have been generated from multiple printer providers”⁴

Applicant submits that the selective picking and choosing of particular elements for the primary reference and seeking to substitute other elements from the secondary reference is a classic instance of an impermissible hindsight reconstruction of the art in the light provided solely by Applicant’s claims. The mere fact that references **can** be modified or combined does not render the combination obvious unless the prior art also suggests the desirability of the combination.”⁵ Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation

² Herbert ‘931, at column 7, lines 26 through 40.

³ Sevek ‘542, column 15, lines 45 and 55.

⁴ Sevek ‘542, column 2, lines 38 through 53.

⁵ *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed.Cir. 1990).

in the reference to do so.”⁶ Accordingly, this rejection fails to demonstrate either motivation or other basis for the Examiner’s proposed combination.

Fourth, absent from the Examiner’s proposed combination is any basis for modifying the *automated Internet quoting ... system*⁷ taught by the primary reference, in order to endow a multiplicity of individual users to separately and simultaneously select and edit attributes of their individual products. Selection in the Examiner’s proposed combination, of an output device to manufacture a document is limited to the printing contractor’s ability to find a printer. In short, the process of the Examiner’s proposed combination expressly allocates the responsibility to find a printer upon the graphics contractor, and allocates the concomitant cost to the “invoicing the printer, the client, or both for the use of the system”⁸; consequently, the Examiner’s proposed combination would impermissibly prevent the primary reference from operating in its intended mode “that provides the printing buyer with an immediate quote ..., thereby significantly reducing estimating cost incurred in the transaction *for both the printing buyer and the printing provider*.”⁹ These discrepancies may not be ignored under the express mandate of 35 U.S.C. §103(a) to consider the “differences” between the pending claims and the prior art. Accordingly, this rejection may not be maintained. Its withdrawal is respectfully urged.

SUMMARY

Unlike the art cited by Paper No. 20070510, pending claims 38 through 81 enable a user seeking to practice Applicant’s inventions to participate in each stage of the process, from product specification, cost estimation, editing and pre-press, final approval and manufacturing. In the various proposed combinations of art poised by the Examiner, the user

⁶ *In re Mills*, 916 F.2d 682, 16 USPQ2d a 1432 (Fed.Cir. 1990). See also, *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

⁷ Sevick ‘542, Title.

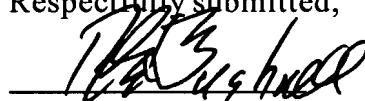
⁸ Herbert ‘931, column 7, lines 39 and 40.

⁹ Sevick ‘542, column 2, lines 45 and 46.

is forced to surrender control over one, or most, of the various steps, to either the graphics contractor or to the printing contractor. Consequently, flexibility is lost and, more significantly, control of the ultimate costs, are shifted by the Examiner's proposed combinations, beyond the user. In contradistinction, a user practicing Applicant's inventions not only participates in the entire process, but is singularly endowed with a flexibility, by way of example, through the user's selections, to make trade-offs during the process such as, by way of example, between his selections during formulation of the product's specifications, or by way of an alternative example, between his selection of printers, or, by way of a second alternative example, by deleting, altering varying content during editing; this flexibility concomitantly enables the user to maintain control over price, timeliness of performance and completion of the job.

In view of the foregoing explanations and demonstrations of the patentable distinctions between the prior art and Applicant's pending claims, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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